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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/675,815

09/30/2003

Philip J. Haarstad

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EXAMINER

GILBERT, SAMUEL G

ART UNIT

PAPER NUMBER

3735

MAIL DATE

DELIVERY MODE

04/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,815	<b>Applicant(s)</b> HAARSTAD ET AL.	
	<b>Examiner</b> Samuel G. Gilbert	<b>Art Unit</b> 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49, 52, 58-82 is/are pending in the application.
- 4a) Of the above claim(s) 1-49, 52, 57, 68 and 77 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 78-82 is/are allowed.
- 6) ☒ Claim(s) 50 and 55 is/are rejected.
- 7) ☒ Claim(s) 51, 53, 54, 56, 58-67 and 69-76 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/3/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

The applicant's arguments regarding claim 52 and 77 are considered a matter of rejoinder which will be considered **when all claims directed to the elected invention** are in condition for allowance as set forth in MPEP 821.04 reproduced in part below.

#### **821.04 Rejoinder [R-3]**

*\*\*>The propriety of a restriction requirement should be reconsidered **when all the claims directed to the elected invention are in condition for allowance**, and the nonelected invention(s) should be considered for rejoinder. Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a nonelected invention and examination of the formerly nonelected invention on the merits.*

Claims 1-36, 52, 57, 68 and 77 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/14/2007.

The applicant argued that claims 37, 50 and 78 are generic because they are generic to two or more species and therefore should be examined. The Examiner disagrees because a claim is only considered generic for restriction/election practice if the claim is generic to all embodiments. Claims 37-49, 52 and 57 are also being withdrawn by the examiner because the elected embodiment does not include a removable 3<sup>rd</sup> portion. The elected embodiment requires the third portion remain on the shaft to attach the suction head.

This application contains claims 1-49, 52, 57, 68 and 77 drawn to an invention nonelected with traverse in the reply filed on 6/14/2007. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 50 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kochamba et al (6,251,065, hereinafter Kochamba) in view of Sterman et al (5,735,290, hereinafter Sterman).

Claim 50 - arm -98- is an elongated shaft is provided, column 9 lines 66,67, element -100- is a shaft fastener element, element -10- is a suction head that is provided, the suction pad is positioned against the heart and suction is applied, column 9 lines 1-64. After the suction pad is position arm -98- is attached by inserting arm -98- and connecting socket -100- with ball -58-. The suction head is provided through a trocar sheath or mini thoracotomy, column 8 lines 63-65. However, the method does not set forth performing the procedure through the second opening. Sterman teaches a coronary bypass method performed through a plurality of trocar sheaths -10-, -12-, -14-, and -16-. A plurality of sheaths are required to allow grasping tools and surgical

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equipment to be used during the procedure, it is generally accepted that one tool is used through one trocar opening and this type of surgery requires a plurality of tools to be used simultaneously. It would have been obvious to one of ordinary skill in the medical arts at the time the invention was made to perform the surgery as set forth by Kochamba through a plurality of surgical incisions with corresponding trocars to allow the method to be performed through by "mini" thoracotomy as set forth by Sterman to gain the advantage of minimally invasive surgery which provides a shorter recovery time thereby reducing patient discomfort and reducing costs of the surgery.

Claim 55 - the shaft is positioned in an operative vector in 3-D space and rigidly maintained to allow the surgery to be performed.

***Allowable Subject Matter***

Claims 51, 53, 54, 56, 58-67, and 69-76 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 78-82 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or fairly suggest a method as claimed including advancing a first portion through a first incision and through a second incision coupling a second portion to the first portion outside the body placing the second portion in engagement with the body organ applying suction and performing the surgery through

the second incision, claim 78; and releasing suction, moving the suction head away from the organ and disconnecting the suction head from the shaft inside the patient, claim 51.

### ***Response to Arguments***

Applicant's arguments filed 1/3/2008 have been fully considered but they are not persuasive. The applicant asserts that it is not clear how Kochamba is being read on claim 50. However the applicant has not specifically pointed out what is unclear. The Examiner has reviewed the rejection and considers each step of the claimed method to be pointed out with the exception of performing the surgical procedure through a second incision. Kochamba sets forth a method using a single large incision and spreading the ribs to access the surgical site. Sterman teaches a surgical procedure using a plurality of incisions called "mini thoracotomy". It is well known in the medical art that using a plurality of small incisions in place of a single large incision, provides for the advantage of a shorter recovery time and less patient pain. Such procedures are known as minimally invasive surgeries. The applicant argues that the diverse systems of Kochamba and Sterman could not be combined to arrive at the present invention. It is the examiner's position that both Kochamba and Sterman are both surgical methods for treating the heart and are therefore considered analogous art.

Regarding claim 55 the applicant argues that Kochamba arm is attached to a bedpost or sternal retractor. It is unclear to the examiner how this attachment affects the ability of the arm to be delivered in a 3-D space and rigidly maintained.

The arm of Kochamba is positioned and maintained in an operative vector rigidly.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571-272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel G. Gilbert/  
Primary Examiner, Art Unit 3735